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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/389,082	09/02/1999	STEPHEN PETER FITZGERALD	104161	4878

25944 7590 03/07/2005

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EXAMINER
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CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/389,082

Applicant(s)

FITZGERALD ET AL.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action is in response to Applicants' remarks filed on September 2, 2004.

Claims 1-3, 6-13 and 15-21 are pending.

#### ***Withdrawal of Rejections from Previous Office Action***

- The obviousness rejection set forth in the previous Office Action is withdrawn in view of Applicants' argument that using a projection in the device of Westhall would prevent the device from operating as it is intended to do.

#### ***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 6-13 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 4,828,386 to Matkovich et al in view of Westhall (EP 569753).

Matkovich et al teach a device having a plurality of storage wells (20). In one embodiment of the reference, Matkovich et al teach a well having projections (72) on the inner surface of the wall of the well (figures 3b and 3c). The projection forms a ring around the inner circumference of the well. Matkovich et al teaches that the projection serves as a retaining ring. Matkovich et al further teach that inserts (40) may be inserted into the wells and used in assaying a sample for the presence of an analyte of interest. The inserts are substrates capable of binding antibody and other biological substances used in binding assays (col. 3, lines 52-55). With respect to claim 3, Matkovich et al teach that the inserts may be cylindrical inserts with closed

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tops and bottoms, that reside on the bottom surface of the well (col. 7, lines 28-31; col. 9, lines 2-8). When in use, the inserts are located within the well (20) between the base and projection (72), as recited in claims 20 and 21. See col. 10, lines 38-45. With respect to claims 6, 11, 12 and 16, the reference shows (figure 1) multiple wells on a plate. With respect to claim 8, figure 3c of the reference shows well (20) having a tapered bottom and projection (72). With respect to claims 10, 13 and the method of forming the wells containing chips, Matkovich et al teach that the multi-well plates may be formed by injection molding or other plastic forming process (col. 3, lines 34-38). The inserts are inserted into the wells and may be held in place by projections (72). See col. 8, lines 23-44.

Matkovich et al differ from the claims of the instant invention in that, while the reference does teach holding binding inserts in the well, there is no disclosure of "chips" being held in the storage wells.

Westhall discloses an apparatus for receiving and storing discs. The discs (3) have biologically active substances are bound it. The discs are equivalent to Applicants' chip. The discs are disposed in a tubular receiving element/storage well (2). It would have been obvious to one of ordinary skill in the art to use the storage wells of Matkovich et al as a means to hold and store biochips in a safe manner until time for use.

Matkovich et al further differ from the instant invention in that a square base is not specifically taught (claim 9). Matkovich et al do teach that the wells may be cylindrical or any other hollow shape (col. 3, lines 38-45). It would have been obvious to one of ordinary skill in the art to make the base of the storage well any shape suitable to sufficiently hold the chips within the well.

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With respect to the projections being "hot or cold formed", such limitation involves how to make the projection and does not sufficiently limit the apparatus claims, which are defined by their structure, to be patentable.

With respect to the trays being arranged in a stack, such would have been obvious to one of ordinary skill in the art to allow easier packaging of the wells and easier shipping.

Therefore, for the reasons set forth above, Applicant's claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Matkovich et al and Westhall.

### ***Response to Arguments***

3. Applicant's arguments filed September 2, 2004 have been fully considered but are moot in view of the new ground of rejection set forth above.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden  
Supervisory Patent Examiner  
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